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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,861	08/20/2001	Rajesh Bhatia	BIZ/01-0008	7426

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EXAMINER

DUNHAM, JASON B

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,861

Applicant(s)

BHATIA ET AL.

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Declaration Pursuant to 37 C.F.R. 1.131

The Declaration filed on July 13, 2006 and supplemental signature pages filed July 19, 2006 and August 8, 2006 under 37 CFR 1.131 is improper, as not all of the inventors have signed the declaration. See the requirements of MPEP 715.04 below.

715.04 [R-2] Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

I. >< WHO MAY MAKE AFFIDAVIT OR DECLARATION

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) **> If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.< .
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

II. >< FORMAL REQUIREMENTS OF AFFIDAVITS AND DECLARATIONS

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits. 37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's

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own knowledge are true and that all statements made on information and belief are believed to be true.

The examiner notes that none of the conditions (a-d) above have been met and no other arguments against the claim rejections as noted below have been submitted. However, if the all of the inventors sign the affidavit, it would be persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-34,36-48, & 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Geddes (U.S. Patent Application Publication No. 2005/0192870).

Referring to claim 26. Geddes discloses a method for context personal browsing comprising:

- Providing a remote computer system, the remote computer system receiving data from a client computer system having a browser companion agent including one or more than one associated service modules that assist a user of the client computer system by providing services that are contextually relevant to content on a browser on the client computer system, the data received by the remote computer system being determined according to the content page present on a

browser of the client computer system or the user associated with the client computer system (Geddes: abstract & paragraphs 77-79);

- Determining from the page data at least one set of data or executable code that corresponds to a service module associated with the browser companion agent (Geddes: paragraphs 102-103 & figures 8-9). The examiner notes that Geddes discloses an “intent interpreter”, which consists of an interface, equivalent to the browser companion agent and a collection of data structures, equivalent to the service module.
- Sending the data or code to the browser companion agent for use by the service module (Geddes: paragraph 17).

Referring to claim 27. Geddes further discloses a method wherein the service module is a comparison shopping service (Geddes: paragraph 9).

Referring to claim 28. Geddes further discloses a method wherein the browser companion agent includes at least two of the service modules (Geddes: paragraph 70).

Referring to claim 29. Geddes further discloses a method wherein the data or code sent to the browser companion agent is determined by parsing the page for elements matching elements in a database, the elements in the database corresponding to the code or data to send to the remote computer system (Geddes: paragraph 77).

Referring to claim 30. Geddes further discloses a method wherein the data or code sent to the browser companion agent is determined by looking up in a database

corresponding code or data to send to the remote computer system (Geddes: paragraph 96).

Referring to claim 31-34. Claims 31-34 are rejected under the same rationale as set forth above.

Referring to claim 36. Geddes further discloses a method wherein the browser comprises a version of Internet explorer and the companion agent comprises a browser helper object (Geddes: paragraph 71).

Referring to claims 37-38. Geddes further discloses a method wherein the data sent to the remote computer system comprises the location identifier for a page on the browser of the client computer system (Geddes: paragraphs 86-87) and wherein the location identifier comprises a URL for the page (Geddes: paragraphs 86-87). The examiner notes that Geddes discloses a method wherein the agent monitors the user's actions while browsing the web as the user changes sites. By monitoring the user's actions, the agent would inherently record the URL for each page surfed.

Referring to claims 39-40. Geddes further discloses a method wherein the data sent to the remote computer system comprises data about the content or structure on the page on the browser of the client computer system (Geddes: paragraphs 86-87).

Referring to claim 41. Geddes further discloses a method comprising:

- From a first computer system, sending a service module for context personalized browsing comprising executable code to a second computer system, the second computer system including a browser companion agent comprising a service component for holding one or more service modules, a service module

comprising code relating to providing a user of the second computer system information relating to an actual or potential e-commerce transaction (Geddes: abstract, paragraphs 77-79, claim 29);

- A data component for holding data related to one or more service modules (Geddes: paragraphs 102-103 & figures 8-9);
- A tracking component for tracking the domain of a page presented on a browser and communicating page domain data to a remote computer system (Geddes: paragraph 114);
- A receiving component for receiving data from the remote computer system responsive to the page domain data, the service module being installable in the service component of the second computer system, the service module being sent to the second computer system also being useful to a user considering an e-commerce transaction (Geddes: paragraphs 91 & 114).

Referring to claim 42. Geddes further discloses a method wherein the agent includes a user interface that is coupable to a browser, the user interface capable of receiving user input and sending the input to a remote computer system or displaying information received from a remote computer system (Geddes: abstract & paragraph 51).

Referring to claim 43-48 & 50. Claims 43-48 and 50 are rejected under the same rationale as set forth above.

Referring to claim 51. Geddes further discloses a method wherein the services are invoked in a predetermined order based on assigned priorities (Geddes: abstract &

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paragraphs 41-42). The examiner notes that Geddes discloses using a partial order planner.

Referring to claim 52-53. Geddes further discloses a method wherein the priority is assignable by the remote computer system or is set by one of the services (Geddes: paragraphs 72-73).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geddes (U.S. Patent Application Publication No. 2005/0192870) in view of Beck (U.S. Patent No. 6,138,139) .

Referring to claims 35 & 49. Geddes discloses all of the above as noted in the 102(e) rejection but does not expressly disclose a method wherein a data or service module comprises a COM object. Beck discloses a method wherein a service module comprises a COM object (Beck: abstract, paragraphs 55-56). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Geddes to have included data or service modules comprising a COM object, as taught by Beck, in order to interact with other electronic commerce applications (Beck: paragraph 56).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD
Patent Examiner
9/26/06

ML
Prm *Ed*